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PATENT  
Attorney Docket No.: 016866-005710



Assistant Commissioner for Patents  
Washington, D.C. 20231

On

TOWNSEND and TOWNSEND and CREW LLP

By:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

RICH et al.

Application No.: 10/076,967

Filed: February 15, 2001

For: METHOD FOR CORRELATING  
GENE EXPRESSION PROFILES WITH  
PROTEIN EXPRESSION PROFILES

Examiner: Not yet assigned

Art Unit: 1645

PETITION UNDER 37 CFR §1.47(a)

Box Missing Parts  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Pursuant to 37 CFR §1.47(a), Applicant hereby petitions the Commissioner to accept the filing of the above-identified patent application by other than all of the inventors when a joint inventor refuses to join in an application for patent. Proof of the pertinent facts is submitted herein with the petition, to properly establish that joint inventor Dr. T. William Hutchens refuses to join in the present application for a patent or cannot be found or reached after diligent effort.

The last know home address of co-inventor Dr. T. William Hutchens, who refuses to join in the application, is as follows: 132 Palmer Ave. Mountain View, CA 94043.

**RECEIVED**  
AUG 16 2002  
OFFICE OF PETITIONS

Co-inventor Dr. William Rich is filing the above-identified patent application on behalf of himself, and on behalf of the non-signing inventor, Dr. Hutchens. A Declaration for the above-identified patent application signed by all the remaining joint inventors (co-inventor Dr. William Rich) with the signature block of the non-signing inventors (Dr. Hutchens) left blank is attached hereto. According to the Manual of Patent Examining procedure § 409.03,

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

The following items are attached hereto as evidence that joint inventor Dr. T. William Hutchens refuses to join in the present application for a patent or cannot be found or reached after diligent effort:

Exhibit A: a photocopy of the letter dated February 21, 2002 sent by undersigned attorney Dr. Annette Parent to Dr. Hutchens' attorney, Mr. Steven A. Ellenberg, which letter offers to provide the above-identified application for review by Dr. Hutchens and a declaration for execution by Dr. Hutchens.

Exhibit B: a photocopy of the letter dated March 7, 2002 from Mr. Ellenberg to Mr. Patrick Jewik, attorney for assignee Ciphergen Biosystems, Inc., assignee of the present application (copied to Dr. Parent), which letter states that Dr. Hutchens would review the above-identified application and sign the declaration only if Ciphergen Biosystems, Inc. forgoes any potential legal claims relating to his review of the above-identified application.

Exhibit C: a photocopy of the letter dated March 8, 2002 from Mr. Jewik to Mr. Ellenberg, stating Ciphergen Biosystems, Inc. does not waive its rights to any legal claims related to review of the applications.

Exhibit D: a photocopy of the letter dated April 22, 2002 from Dr. Parent to Dr. Hutchens enclosing a copy of the above-identified patent application for review and a declaration for execution.

Exhibit E: a photocopy of Registered Mail receipt (dated April 23, 2002), indicating the mailing of a declaration, assignment, and the letter of April 22, 2002 to Dr. Hutchens.

Exhibit F: a photocopy of a return postcard (dated May 8, 2002), indicating that the items mailed on April 23, 2002 to Dr. Hutchens were signed for by Ms. Mary Jo Hutchens.

Please charge \$130.00 for filing this petition to Deposit Account 20-1430. The Commissioner is hereby authorized to charge any additional fees associated with this petition or credit any overpayment to the Deposit Account identified above.

#### REMARKS

The following remarks and evidence are offered to demonstrate why Dr. Hutchens refuses to join in the present application for a patent.

On February 21, 2002, undersigned attorney Dr. Parent sent a letter to Dr. Hutchens' attorney Mr. Ellenberg (Exhibit A). This letter requested that Dr. Hutchens review the above-identified patent application (client reference no. 016336-005710) and execute a declaration, subject to certain confidentiality conditions, as the patent application was not yet published and was therefore proprietary to the assignee, Ciphergen Biosciences, Inc. On March 7, 2002, Mr. Ellenberg sent a reply letter to Mr. Jewik, with a copy to Dr. Parent (Exhibit B). In the letter, Mr. Ellenberg referred to the priority application for the above-identified patent application (USSN 60/269,772), and stated that Dr. Hutchens would review the application and sign the declaration only if Ciphergen Biosciences, Inc. released Dr. Hutchens from all legal claims relating to his review. On March 8, 2002, Mr. Jewik replied to Mr. Ellenberg (Exhibit C). The letter stated that Ciphergen Biosystems, Inc. did not agree to a waiver of legal rights, as Dr. Hutchens had an obligation pursuant to his employment agreement with Ciphergen Biosystems, Inc. to "assist the Company in every proper way to obtain . . . United States and foreign Proprietary Rights relating to Company inventions." The letter further stated that because Dr. Hutchens would only conditionally review the application and sign the

declaration, Applicant had no choice but to proceed with prosecution of the application with Dr. Hutchens named as an uncooperative inventor.

On April 22, 2002, Dr. Parent sent a copy of the above-referenced patent application and a declaration for execution to Dr. Hutchens via registered mail with return receipt requested to his last known home address (Exhibits D-F). Ms. Mary Jo Hutchens, signed the registered mail receipt (Exhibit F), indicating that Dr. Hutchens received the application and declaration. However, to date, Dr. Hutchens has not returned the executed declaration to Dr. Parent.

As described above, Dr. Hutchens' conduct constitutes a refusal to join the in patent application, and he is therefore an uncooperative inventor. At least two attempts were made to present the patent application and declaration to Dr. Hutchens for review and execution. Despite these two opportunities, Dr. Hutchens has refused to review the patent application and to execute a corresponding declaration. In view of this refusal, co-inventor Dr. Rich is therefore believed to be entitled to make application on behalf of and as agent for co-inventor Dr. Hutchens. Applicant therefore respectfully request that the petition be granted.

Respectfully submitted,

  
Annette S. Parent  
Reg. No. 42,058

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
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ASP:cg  
SF 1349867 v1

February 21, 2002

Steven A. Ellenberg, Esq.  
Ruby & Schofield  
60 South Market Street, Suite 1500  
San Jose, CA 95113-2379

Re: U.S. Provisional Patent Application for:  
**METHOD FOR CORRELATING GENE EXPRESSION PROFILES WITH PROTEIN  
EXPRESSION PROFILES**  
Serial No. 60/269,772; Filed: February 16, 2001  
Our File No.: 016866-005710US

Dear Mr. Ellenberg:

Further to our telephone conversation of February 7, 2002, we believe that Dr. Hutchens may be a co-inventor of subject matter in a patent application owned by Ciphergen Biosystems, Inc. ("Ciphergen"). The subject matter that we believe was co-invented by Dr. Hutchens was conceived of while he was at Ciphergen. The subject patent application was originally filed as a provisional application, and was converted into a US and PCT application on the one year anniversary of filing. The US and PCT applications are identical to the provisional application and claim priority to the provisional application.

We would like to have Dr. Hutchens review the patent application as well as the priority provisional application. If, after reviewing the application, he believes that he is a co-inventor, we would like him to sign a declaration for the patent application.

In this regard, we are willing to send a copy of the patent application and a declaration for the patent application, and a copy of the priority provisional application listed in the declaration for Dr. Hutchens' review and signature, subject to the following conditions:

- (1) No copies of the present application, the declaration, nor the priority provisional application will be made at any time by anyone while these documents are in your possession.
- (2) You will be present when Dr. Hutchens reviews the present application, the declaration, and the priority application.
- (3) Dr. Hutchens will not take notes during his review of the present application, the declaration, and the priority application.


(4) The present application, the declaration, and the priority provisional application will be returned to me within two weeks after you receive them, whether or not Dr. Hutchens has reviewed these documents.

If you agree to the above conditions, please sign the enclosed copy of this letter and return it to us. After we receive your written acceptance of these conditions, we will forward the patent application and the associated documents to you on a date designated by you.

Please don't hesitate to contact me if you have any questions.

Very truly yours,

TOWNSEND AND TOWNSEND AND CREW, LLP



Annette S. Parent, Ph.D., J.D.

Enclosures

cc: John Storella, Esq.

By: \_\_\_\_\_ Date: \_\_\_\_\_  
Steven A. Ellenberg

03/07/02 THU 10:15 FAX 408 998 8503 RUBY & SCHOFIELD

# RUBY & SCHOFIELD

A PARTNERSHIP OF LAW CORPORATIONS

60 SOUTH MARKET STREET, SUITE 1500  
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TELEPHONE: (408) 998-8500  
FACSIMILE: (408) 998-8503

March 7, 2002

VIA FACSIMILE & MAIL

Patrick R. Jewik, Esq.  
Townsend and Townsend and Crew  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, CA 94111

Re: U.S. Patent Application  
For: Method and Apparatus for Identifying Proteins  
Your File No: 016866-002711US  
Our File: HU104-1

Dear Patrick:

We have been exchanging letters related to whether Dr. William Hutchens will further review a patent application and provide an initial review of associated documents to be filed by your client Ciphergen Biosystems, Inc. for the purposes of his executing a declaration and assignment. (You had never previously requested that Dr. Hutchens sign an assignment.) Your colleague, Annette S. Parent, has also requested that Dr. Hutchens review another patent application, (serial no. 60/269,772), one with which we are completely unfamiliar. You have forwarded the materials for my review first. After reviewing the volume of information provided for Dr. Hutchens' review, and in light of the request that Dr. Hutchens review and sign additional oaths relating to a different application, we believe it is necessary to further address the awkward situation in which your requests of Dr. Hutchens arise.

As you know, Ciphergen has sued Dr. Hutchens individually for breach of his employment agreement with Ciphergen, claiming that he misappropriated Ciphergen trade secrets and violated various confidentiality provisions. Dr. Hutchens denies these accusations.

Nevertheless, Dr. Hutchens is willing to review the patent applications in question for the above-stated purpose under the following condition: Ciphergen must agree in writing that it will forego any potential legal claims against him in the future related to these reviews. Given that Ciphergen has shown no reticence about accusing Dr. Hutchens of violating confidences, Dr. Hutchens is understandably wary of reviewing materials that Ciphergen believes to be confidential, and expose himself to

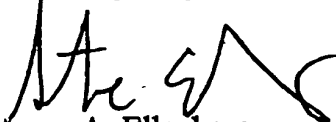
Patrick R. Jewik, Esq.  
March 7, 2002  
Page 3

further claims by CIPHERGEN for alleged misappropriation or publication of that confidential information.

If CIPHERGEN is unwilling to agree to this proposal, then Dr. HUTCHENS is willing to review the patent application after it publishes (at 18 months or perhaps sooner after its priority date), to determine whether the execution of a declaration and/or assignment is appropriate.

Please let us know how you would like Dr. HUTCHENS to proceed.

Yours very truly,



Steven A. Ellenberg

:mj

cc: Annette S. Parent, Esq.

I:\Hutchens\C\Jewik March 7 02.doc



**TOWNSEND**  
*and*  
**TOWNSEND**  
*and*  
**CREW**  
L.L.P.

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Tel 415 576-0200  
Fax 415 576-0300

prjewik@townsend.com

March 8, 2002

***VIA FACSIMILE***

**Confirmation via Certified Mail, Return Receipt Requested**

Steven A. Ellenberg, Esq.  
Ruby & Schofield  
60 South Market Street, Suite 1500  
San Jose, CA 95113-2379

Re: U.S. Patent Applications for Dr. Hutchens' review  
Our File Nos.: 016866-002711US and 016866-005710US  
Your File No.: HU104-1

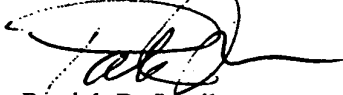
Dear Steven:

Thank you for your letter of March 7, 2002.

Ciphergen is not willing to agree to the condition proposed in your letter (i.e., forgo any potential legal claims against Dr. Hutchens in the future related to the review of the applications). Dr. Hutchens is a former employee of Ciphergen Biosystems, Inc. On April 7, 1997 he executed a "Proprietary Information And Inventions Agreement" in which he agreed to "hold in strictest confidence" Ciphergen's Proprietary Information and to "assist the Company in every proper way to obtain and from time to time enforce United States and foreign Proprietary Rights relating to Company Inventions." Dr. Hutchens' obligation to respect the terms of this agreement is not conditioned on Ciphergen waiving its rights, and Ciphergen has no intention of waiving its rights in this regard. Accordingly, Ciphergen now has no choice but to proceed with prosecution of these patent applications naming Dr. Hutchens as an uncooperative inventor in both the above application and in the application that Dr. Parent is handling (patent application relating to 60/269,772).

Please return the documents forwarded with our letter of March 1, 2002 to us at your earliest opportunity.

Very truly yours,



Patrick R. Jewik

PRJ

cc: John Storella, Esq. (Ciphergen Biosystems, Inc.)  
Jeffrey Chanin, Esq.  
Annette Parent, Esq.

SF 1324368 v1

TOWNSEND  
and  
TOWNSEND  
and  
CREW

LLP

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April 22, 2002

VIA REGISTERED MAIL, RETURN RECEIPT REQUESTED

T. William Hutchens, Ph.D.  
132 Palmer Avenue  
Mountain View, CA 94043

Re: U.S. Patent Application for:  
METHOD FOR CORRELATING GENE EXPRESSION PROFILES WITH  
PROTEIN EXPRESSION PROFILES  
Application No.: 10/076,967 Filed: February 15, 2002  
Our File No.: 016866-005710US

Dear Dr. Hutchens:

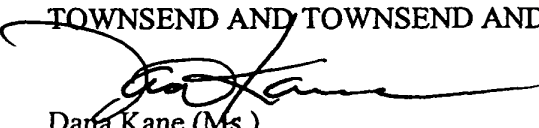
Enclosed for your signature are a Declaration and an Assignment to Ciphergen Biosystems, Inc. for the above-referenced patent application. Also enclosed is a copy of the application as filed in the United States Patent and Trademark Office on February 15, 2002. As you may be aware, US patent laws require you to read the application before executing the Declaration.

We hope to have the executed documents in hand before May 8, 2002 when the response to the Notice to File Missing Parts of Nonprovisional Application is initially due.

Please do not hesitate to contact us, should you have any questions on the enclosed documents.

Very truly yours,

TOWNSEND AND TOWNSEND AND CREW LLP

  
Dana Kane (Ms.)  
assistant to Annette S. Parent

/dk  
Enclosures  
SF 1339006 v1